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Jodi Hobbs

Name

Jodi Hobbs

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May 1, 2008

Date

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Jansen, *et al.*

Serial No.: 10/579,111 - Case No.: 21561P

Art Unit:

1648

Filed: May 11, 2006

Examiner:

Salimi, A.R.

For: OPTIMIZED EXPRESSION OF HPV 58 L1 IN YEAST

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT ACCOMPANYING
A PETITION TO WITHDRAW HOLDING OF ABANDONMENT
BASED ON FAILURE TO RECEIVE OFFICE ACTION

Sir:

This communication accompanies a Petition to Withdraw Holding of Abandonment Based on Failure to Receive Office Action pursuant to M.P.E.P. §711.03(c) and 37 C.F.R. § 1.181. Upon withdrawal of the holding of abandonment, Applicants request entry of this response, which replies to the Restriction Requirement mailed by the Office on June 21, 2007. Reconsideration and allowance of the above-identified patent application are respectfully requested.

Applicants believe that no fee is due in connection with this submission. However, in the event any extension of time is required, please treat this paper as a request under 37 C.F.R. §1.136(a) to extend the time as required, and charge Deposit Account No. 13-2755 the appropriate fee as a large entity. Please credit any overpayment or charge any fee deficiency, related to this or any accompanying submission, to Deposit Account No. 13-2755.

The Office Action states that the application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1:

- Group I, claims 1, 2, 7-8 → drawn to nucleic acid molecule comprising a nucleotide sequence of HPV 58 L1.
- Group II, claims 3-6, 9 → drawn to host cells
- Group III, claims 10-18 → drawn to virus-like particles of HPV-58, vaccines, method of making and using.
- Group IV, claims 20-25 → drawn to multivalent vaccines.
- Group V, claims 29 → drawn to isolated polypeptide.

The Office Action further states that Applicant is required to elect a single one of these inventions to which the claims must be restricted.

By way of this response, Applicants respectfully traverse the Lack of Unity of Invention/Restriction Requirement set forth above. However, in order to be fully responsive, Applicants provisionally elect Group I, claims 1, 2, 7-8, without prejudice to the prosecution of the non-elected claims in related patent applications.

Under PCT Rule 13.1, inventions that are so linked as to form a single general inventive concept may be examined and prosecuted in a single case. As stated in the Office Action, if a group of claims share the same or corresponding special technical feature, one that identifies a contribution over the prior art, then those claims are so linked as to form a single general inventive concept. In the present case, Applicants traverse the restriction of Groups I and II because these groups of claims clearly share the same or special technical feature which contributes over the prior art.

Group I contains claims to nucleic acid molecules comprising a sequence of nucleotides encoding HPV58 L1, said sequence codon-optimized for high expression in a yeast cell, and vectors comprising said nucleic acid molecule. Group II contains claims to host cells comprising said vectors. Each of the claims in the referenced groups describes a codon-optimized nucleic acid molecule comprising a sequence of nucleotides encoding HPV58 L1, which is the special feature that is shared by the two groups. Prior to the present invention, nucleic acid molecules comprising the claimed elements were not known in the art. Moreover, because the same novel special technical feature is present in each of these claims, it would require no additional USPTO resources or present a burden on the USPTO to examine Group I and II claims in a single application. Thus, all claims in groups I and II share a special technical feature that provides a contribution over the prior art. Accordingly Applicants respectfully

submit that it is not proper to restrict the claims of Groups I and II into separate applications based on PCT Rule 13.2.


Applicants also note that according to PCT Rule 13.4, it is permissible to include in the same application a reasonable number of dependent claims, claiming specific forms of an invention claimed in an independent claim, even where the features of any dependent claim could be considered as constituting in themselves an invention. In the present case, claims 2-9 (Groups 1 and 2), which all depend on claim 1, present specific forms of the invention described in claim 1. As such, Applicants submit that it is not proper to restrict the claims in Groups I and II, pursuant to PCT Rule 13.2, as discussed in the previous paragraph, and pursuant to Rule 13.4, as discussed above.

Applicants, therefore, respectfully submit that Groups I and II (claims 1-9) should properly be examined in a single group in accordance with PCT Rules 13.2 and 13.4. As such, reconsideration and withdrawal of the requirement for restriction and/or regrouping of the claims, e.g., by combining Group I- and Group II (claims 1-9) is respectfully requested.

Applicants assert all claims are in condition for allowance and a favorable action on the merits is earnestly solicited.

If the Examiner believes that a telephone conference would be of value, he is requested to call the undersigned attorney at the number listed below.

Respectfully submitted,

By 
Alysia A. Finnegan
Reg. No.: 48,878
Attorney for Applicants

MERCK & CO., INC.
P.O. Box 2000
Rahway, NJ 07065-0907
(732) 594-2583

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